

## REMARKS

### Request for Reconsideration

Applicants have carefully considered the matters by the Examiner in the outstanding Office Action but remain of the opinion that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the above amendments to the claims and the following remarks.

### Affirmation of Election

Restriction had been put forward between Claims 1-6, drawn to the toner, and Claims 7-17, drawn to the image forming method. Applicants had elected Group I, Claims 1-6, drawn to the toner. Applicants hereby affirm this Election without traverse.

### Claims Status and Amendments

Claim 1 has been amended herein to recite that the toner comprises external additives along with a resin and colorant. The external additives are recited as comprising a small-sized external additive and a large-sized external additive. A small-sized external additive is recited as having a number average primary particle diameter of 30 nm

or less while the large-sized external additive is recited as having a number average primary particle diameter of 100 nm or more. The use of both of the two different sized external additives and its benefits are brought out in the first paragraph on page 21. The size limitation for the small-sized external additives can be found on the first full paragraph on page 24 while the support for the size of the large-sized external additive can be found on the second paragraph on page 27.

Claim 1 has also been amended herein to recite that the toner has a peak or a shoulder in molecular weight distribution in the range of from 100,000 to 1,000,000 and 1,000 to 50,000. Support for this limitation can be found on page 8, in the first full paragraph.

Because of the amendments made to Claim 1, Claims 2-5 have been canceled. The Examiner will note that the amendments made to Claim 1 incorporate the limitations of Claims 3, 4 and 5.

For purposes of clarification, Claim 6 has also been amended herein to clarify that the external additive having a number average primary particle diameter which is between

15 and 70 nm and having a larger diameter than the small-sized external additive is a third external additive. For consistency, this third external additive has been referred to as a medium sized external additive. The term "medium sized" has been employed for purposes of clarification since Claim 1 now recites that it comprises a small-sized external additive and a large-sized external additive. Respectfully, no new matter has been added by referring to this third external additive as a "medium-sized" external additive.

Because of the election to Claims 1-6, Claims 7-17 have been canceled.

Furthermore, Claims 18-35 have been added to fully describe the toner of the present Invention. Support for Claims 18-35 is as follows:

<u>Claim</u>	<u>Support in Specification</u>	
	<u>Page</u>	<u>Paragraph</u>
18,31	15	(a)
19,32	27	2
20,27	24	1
21, 26, 35	23	1
22, 24	14	1
23,25	14	2
28	25	1
29	27-28	Bridging
30	5	1,3
	27	2,5
	24-25	Bridging
33	5	1,3,4,5
	27	2
34	27	2
	24	1

Thus, the claims currently under prosecution are Claims 1, 6, and 18-35.

## Specification Amendments

The specification has been amended herein to correct some obvious typographical errors. On pages 5, 7, and 20, clarification has been made between the large-sized external additives and the external additives which has a particle diameter greater than the small-sized external additives but in the range of 15 to 70 nm. Respectfully, no new matter has been added by this slight rewording of these portions of the Specification.

The remaining amendments to the Specification have been made to change "colorant particles" to "colored particles". Obviously, this is a grammatical change and does not affect the scope of the claims in any way.

## Prior Art Rejection

Claims 1, 2 and 4-6 have been rejected as being unpatentable over Inaba. This rejection is deemed moot in light of the fact that the limitations of Claim 3 have been added to Claim 1. It should be noted that the limitations of Claim 3 also appear in the other two independent claims, namely, Claims 30 and 33. Thus, it is submitted that Claims 1, 6, and 18-35 are patentable over Inaba.

Claims 1-6 were rejected as being anticipated by Kohyama. As noted above, Claim 1 has been amended herein to recite that toner has external additives and that the external additives are made up of small-sized external additives having a number average primary particle diameter of 30 nm or less and a large-sized external additive having a number average primary particle diameter of 100 nm or more.

In Kohyama, he teaches the use of external additives, see Paragraph 0236-0243. Kohyama also teaches that these external additives can be fine inorganic particles, see Paragraph 0237. Kohyama fails to teach the use of different sized external additives and specifically does not teach using small-sized external additives having a diameter of 30 nm or less and large-sized external additives having a diameter of 100 nm or more. Thus, it is submitted that one of skill in the art is not provided with a suggestion nor a teaching that the toner made in accordance with Kohyama should have two different sized external additives nor that these two different sized external additives should have diameters of 30 nm or less and 100 nm or more.

It is true that in Paragraph 0413 of Kohyama, he teaches that the external additives have a size of 10 nm and 25 nm. However, this falls far short of the claims of the present Invention in that Kohyama still is not teaching the use of two different external additives and that fact that one of the external additives has a size of 30 nm or less and the other has a size of 100 nm or more. Respectfully, Kohyama does not teach nor suggest these two different sized external additives wherein one of the external additives has a diameter of 30 nm or less and the other has an external diameter of 100 nm or more. In view of the foregoing, it is respectfully submitted that Claim 1 is clearly patentable over Kohyama.

Since Claim 6 is dependent on Claim 1, it is respectfully submitted that Claim 6 is also patentable over Kohyama for the same reasons that Claim 1 is patentable over Kohyama.

With respect to the added Claims 18-35, it will be noted that Claims 18-29 ultimately depend upon Claim 1 as amended herein. Thus, it is submitted that Claims 18-29 are patentable over Kohyama for the same reason that Claims 1 and 6 are patentable over Kohyama.

With respect to Claim 30 and its dependent Claims 31 and 32, it will be noted that Claim 30 recites that the toner has a large-sized external additive having a primary particle diameter of 100 nm or more and that this large-size external additive comprises one or more inorganic oxides. As noted, Kohyama teaches that the external additives can be inorganic particles and that a number of these inorganic particles are oxides, see Paragraph 0238. What is missing from Kohyama is the fact that these inorganic particles have a size in the range of 100 nm or more. In fact, it is noted by Paragraph 0413, Kohyama is teaching that these inorganic oxides have a particle size in the range of 10 to 25 nm not 100 nm or more. The Examiner's attention is directed to Paragraph 0241 wherein Kohyama does teach that the organic particles, which can be used as external additives, can have a particle size of 10 to 2000 nm. This teaching, however, is for the organic particles not inorganic particles. As noted before, the teachings for the inorganic particles, as recited in Paragraph 0413, is for a much smaller-sized particle.



Thus, it is submitted that Claim 30 and its dependent Claims 31 and 32 are patentable over Kohyama because Kohyama is not teaching that a large-sized external additive, which is an inorganic oxide and has a particle diameter of 100 nm, is employed as an external additive.

With respect to independent Claim 33 and its dependent Claims 34 and 35, it is noted that Claim 33 recites that the toner comprises external additives and that those external additives comprise both small-size external additives and large-size external additives having the diameters as recited in Claim 1. Thus, it is submitted that Claim 33 and its dependent Claims 34 and 35 are patentable over Kohyama for the same reasons as given for Claim 1 and its dependent claims.

#### Extension of Time

Applicants hereby request a three-month Extension of Time and enclose PTO Form 2038 authorizing payment of the appropriate government Extension Fee.

Conclusion

In view of the foregoing, it is respectfully submitted that the Application is in condition for allowance and such action is respectfully requested. Should any further fees or extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit account #02-2275.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By: Donald C Lucas  
Donald C. Lucas, Reg. #31,275  
(Attorney for Applicants)  
475 Park Avenue South  
New York, New York 10016  
Tel. # (212) 661-8000

DCL/mr

Encl: Executed PTO Form 2038  
Return receipt post-card